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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,242	02/14/2001	James C. Danly, SR.	3654.006	1570

7590

09/04/2003

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EXAMINER

JOHNSON, JERRY D

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,242

Applicant(s)

DANLY, ET AL.

Examiner

Jerry D. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) 1-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danly, Sr. in view of Ecer, Sato et al. and Takahashi et al.

Danly, Sr., U.S. Patent 5,094,548, teaches a composite bushing which employs a monolithic steel body and a compacted and sintered porous bearing layer (column 2, lines 58-62). The porous bearing layer is a compacted and sintered material, such as bronze, lead alloy, tin, tin alloy or other material well known to those of ordinary skill in the art (column 4, lines 57-63). Danly, Sr. differs from the instant claims in not teaching the addition of a "hardfacing" material to the bearing layer.

Ecer, U.S. Patent 4,474,861; Sato et al., U.S. Patent 5,466,276 and Takahashi et al., U.S. Patent 6,082,317, are relied on as teaching the addition of materials of high hardness to a metal matrix in order to improve the wear resistance of said metal. See, for example, Sato et al. column 6, lines 34+.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a "hardfacing" material to the bearing layer of Danly, Sr. in order to improve the wear resistance of said bearing layer.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 2 and 4-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 2 and 4-12, the term "percolation limit" is indefinite.

Applicant's arguments filed May 28, 2003 have been fully considered but they are not persuasive.

Applicants argue

Applicants distinguish their present invention from Ecer by the mere fact that Ecer creates the possibility for the use of lubrication. The present application is unique and novel because it completely eliminates the requirement for lubrication. (Remarks, page 8).

Applicants' argument lacks merit.

The claims are directed to a composition, not a method. Accordingly, whether or not Ecer "creates the possibility for the use of lubrication" cannot distinguish the instant claims.

Applicants argue

the present invention has **replaced the prior art devices in the industry**. For example, major companies have standardized the present invention on all discs and plastic moulds because it outperforms all other devices. (Remarks, page 9).

Applicants further argue "extensive testing and experiments yielded an unexpected result."

(Remarks, page 10). Applicants' arguments lack merit.

Attorneys arguments unsupported by factual evidence do not take the place of objective evidence of unobviousness. *In re Lindner*, 173 USPQ 356. Furthermore, the burden of proving unexpected results rests on the party which asserts them. In proving such results, it is not enough just to show that certain results are obtained. The results to be probative of nonobviousness must be shown to have been unexpected to the skilled worker in the art. *In re D'Ancicco*, 439 F.2d

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1244, 169 USPQ 303 (CCPA 1971); *In re Klosak*, 455 F.2d 1077, 173 USPQ 14 (CCPA 1972); *In re Juillard*, 476 F.2d 1380, 177 USPQ 1570 (CCPA 1973). Moreover, it is axiomatic that evidence presented to rebut a prima facie case of obviousness must be commensurate in scope with the claims the evidence is offered to support. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971). Accordingly, applicants have not met their burden of proving unexpected results for the claimed compositions.

Applicants argue the phrase "percolation limit" is well known to those skilled in the art; the definition of "percolation limit" can also be found in many online websites and; the phrase "percolation limit" is extremely quantifiable and definite.

Initially it is noted that applicants have not provided a reference which shows that the phrase "percolation limit" is well known to those skill in this art or pointed to where in the specification the phrase "percolation limit" is defined. As to the paper "Introduction to Percolation Theory" by Professor Junqiao Wu, it appears that percolation limit is used to define a condition boundary or critical value. Accordingly, absent a definition of the measured value or condition the phrase "percolation limit" is being applied to, the term is indefinite. Further, it is noted that on page 11 of the remarks, applicants define percolation limit as about 15%, i.e., "at the percolation limit around 15%." Yet the specification teaches bearing compositions containing 20 wt% of hardfacing composition (See, for example, page 7, lines 22-29).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

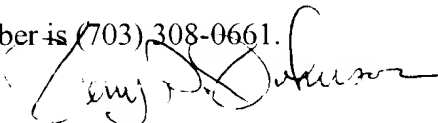
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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (703) 308-6824. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ